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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,734	09/18/2003	Brian Jones	60001.0274US01/MS # 30420	4716
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Leonard J. Hope, Esq. Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0903			EXAMINER BASEHOAR, ADAM L	
			ART UNIT 2178	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/664,734	JONES ET AL.	
	Examiner	Art Unit	
	Adam L. Basehoar	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 and 20 is/are allowed.
- 6) ☒ Claim(s) 1-18, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/30/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: The Application filed 09/18/03.
2. Claims 1-22 are pending in the case. Claims 1, 12, and 19, are independent claims.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 01/30/04 has been considered by the examiner.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 10, 17, 18, 21, and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
6. Claims 10, 17, and 21 are considered non-statutory because the computer readable medium could a communication media including a propagated signal data signal (Specification: Page 4, lines 18-20; Page 6, lines 12-16). Thus the claims are rejected under 35 U.S.C. 101 for failing to fall within a statutory category and for failing to be structurally and functionally interconnected with the software in such a manner to, in and of itself, enable any usefulness to be realized. The Examiner suggests the Applicant amend the claim to include an appropriate computer readable medium (i.e. a computer readable storage medium).

Claims 18 and 22 are considered non-statutory because the claimed apparatuses could be implemented in software alone (Specification: Page 4, lines 18-20; Page 5: Lines 15-16). The claimed apparatuses must be claimed with an appropriate hardware component to enable the functionality to be realized.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 6 and 9 rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Claims 6 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 6, the claim is considered indefinite for failing to particularly point out what the result would be if it was determined that the new content contained direct formatting that was not permitted. As currently claimed only the determined not permitted styles are acted upon when identified.

The term "smaller than" in claim 9 is a relative term which renders the claim indefinite. The term "smaller than" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention..

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Piersol et al (US-5,745,910 04/28/98).

-In regard to independent claim 1 and dependent claims 10 and 11, Piersol teaches a method for restricting the application of formatting to the electronic document, comprising:

receiving a request to perform a formatting operation on a portion of the contents of the document (column 18, lines 31-67; column 19, 1-31: “a user can retrieve an entire document to view it and edit the individual parts as desired”);

determining whether the requested formatting operation was permitted (column 18, lines 31-67; column 19, 1-31: “individual parts can be protected with limited access rights...access restrictability is another characteristic property of a part...other properties of a restricted part are still available to the users of the system”); and

in response to determining the operation was not permitted (column 18, lines 31-67; column 19, 1-31: i.e. the requesting user does not have the access rights as determined by the part), denying the request to perform the formatting operation (column 19: lines 10-14).

Claim Rejections - 35 USC § 103

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11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 5-9, 12, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piersol et al (US-5,745,910 04/28/98) in view of Fein et al (US-6,088,711 07/11/00).

-In regard to dependent claim 2, Piersol teaches restricting the access for editing a document part based on limited access (column 18, lines 31-67; column 19, 1-31).

Piersol does not specifically teach wherein requested editing operation comprises a direct formatting operation and wherein determining whether the formatting operation was permitted comprises determining whether direct formatting of the contents of the electronic document was permitted. Fein teaches wherein a user could edit a document via direct formatting (column 1, lines 63-67; column 2, lines 1-16: "using direct formatting"). It would have been obvious to one of ordinary skill in the art at the time of the invention for the user of Piersol to have been restricted from editing a document part based on direct formatting as taught in Fein, because Fein teaches that direct formatting was tedious and time consuming (column 2, lines 1-16: "direct formatting...tedious and time-consuming") compared to the advantages of applying formatting through styles (column 1, lines 54-62).

-In regard to dependent claim 5, Piersol teaches restricting the access for editing a document part based on limited access (column 18, lines 31-67; column 19, 1-31).

Piersol does not specifically teach the application of a style to a portion of the contents of the electronic document and wherein determining whether the requested formatting operation was permitted comprises determining whether the style is permitted to be applied to the contents of the document. Fein teaches wherein a user could edit a document via the application of user selected styles (column 1, lines 15-62; column 2, lines 17-32: “a style is a set of named formatting properties”). It would have been obvious to one of ordinary skill in the art at the time of the invention for the user of Piersol to have allowed editing to a document part based on style formatting as taught in Fein, because Fein teaches that the application of style formatting provided well known advantages (column 1, lines 54-67; column 2, lines 1-17: “advantages of styles are well known”).

-In regard to dependent claim 6, Piersol teaches importing new content into the electronic document (column 17, lines 62-67; column 18, lines 1-31: “contents moved from one document to another”), wherein determining whether the requested operation was permitted comprises determining whether the new content contains one or more styles that are not permitted to be applied to the contents (column 17, lines 62-67; column 18, lines 1-31: “determines whether they belong to the same category...styled text and the destination is plain text”), and further comprises replacing the styles contained in the new content that are not permitted with a permitted style prior to importing the new content (column 17, lines 62-67; column 18, lines 1-31: “the system converts the selected information into the same type as the destination document”).

-In regard to dependent claim 7, Piersol teaches wherein the permitted style was user selectable (column 17, lines 62-67; column 18, lines 1-31: i.e. the permitted style was user selectable in that the user created document's intrinsic style was user selectable which correlated to the permitted style).

-In regard to dependent claim 8, Piersol comprises determining whether editing operations are permitted to modify the formatting of a part of a document based on access rights (column 18, lines 31-67; column 19, 1-31).

Piersol does not specifically teach wherein the editing operation was a programmatic operation that would result in the modification of the formatting of a portion of the electronic document and wherein determining whether the requested formatting was permitted based on the programmatic operation. Fein teaches wherein a user could edit a document via the programmatic application of user selected style or style sheet (column 1, lines 15-62; column 2, lines 17-32: "a style is a set of named formatting properties....all of the chapter titles....style would reflect the redefined style"). It would have been obvious to one of ordinary skill in the art at the time of the invention for the user of Piersol to have allowed editing to a document part based on the application of a programmatic style formatting operation as taught in Fein, because Fein teaches that the application of style formatting provided well known advantages (column 1, lines 54-67; column 2, lines 1-17: "advantages of styles are well known").

-In regard to dependent claim 9, Piersol teaches wherein the user could view and edit the individual parts of an entire document (column 18, lines 31-67; column 19, 1-31: “view it and edit...as desired”) based on access rights.

Piersol does not specifically teach determining whether the portion of the contents of the document comprises a smaller portion than a paragraph and whether the style comprises a paragraph style; and in response to determining that the portion is smaller than a paragraph and the style comprises a paragraph style, applying the style to the paragraph containing the portion if it was determined that the requested formatting operation was permitted. Fein teaches determining whether the portion of the contents of the document comprises a smaller portion than a paragraph (column 3, lines 24-36: “determining whether the paragraph is one line in length”; column 6, lines 63-65: “as short as one line in length”) and whether the style comprises a paragraph style (Figs. 2A-2B: “Match...existing style” & “Determine appropriate style to define”); and in response to determining that the portion is smaller than a paragraph and the style comprises a paragraph style, applying the style to the paragraph containing the portion if it was determined that the requested formatting operation was permitted (Figs. 3A-3B: “Paragraph type is body text” & “Paragraph type is heading”). It would have been obvious to one of ordinary skill in the art at the time of the invention for the user of Piersol to have allowed editing to a document part based in response to determining that the portion is smaller than a paragraph and the style comprises a paragraph style as taught in Fein, because Fein teaches that the application of paragraph style formatting provided well known advantages (column 1, lines 54-67; column 2, lines 1-17: “advantages of styles are well known”) to include the removal of any direct formatting of the paragraph (column 9, lines 5-11: “direct formatting...removed”).

-In regard to independent claim 12 and dependent claims 17 and 18, Piersol teaches a method for limiting formatting to the contents of document, comprising:

receiving a request to apply formatting to contents of the document (column 18, lines 31-67; column 19, 1-31: "a user can retrieve an entire document to view it and edit the individual parts as desired").

Piersol does not specifically determining whether the request comprises a request to apply formatting directly to the contents of the electronic document or a request to apply a style to the contents of the electronic document; in response to determining that the request comprises a request to apply formatting directly to the contents of the electronic document, denying the request; in response to determining that the request comprises a request to apply a style to the contents of the electronic document, determining whether the style may be applied to the document; and applying the style if the style may be applied to the document. Fein teaches wherein a user could edit a document via direct formatting (column 1, lines 63-67; column 2, lines 1-16: "using direct formatting"). Fein further teaches wherein a user could edit a document via the application of user selected styles (column 1, lines 15-62; column 2, lines 17-32: "a style is a set of named formatting properties"). Fein further teaches establishing a preference between direct and style based formatting (column 1, lines 43-67; column 2, lines 1-48) and applying style based formatting (column 1, lines 43-67; column 2, lines 1-48). It would have been obvious to one of ordinary skill in the art at the time of the invention for Piersol to have determined the formatting request between direct and style, and to deny the formatting if it constituted direct formatting and to accept and apply the formatting if it constituted style formatting, because Fein

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taught that direct formatting was tedious and time consuming (column 2, lines 1-16: “direct formatting...tedious and time-consuming”) and that the application of style formatting provided well known advantages (column 1, lines 54-67; column 2, lines 1-17: “advantages of styles are well known”).

13. Claims 3, 4, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piersol et al (US-5,745,910 04/28/98) in view of Fein et al (US-6,088,711 07/11/00) in further view of Young (01/23/01 6,177,933).

-In regard to dependent claim 3, Piersol and Fein do not specifically teach displaying an error message indicating that direct formatting of the contents of the document was not permitted. It would have been obvious to one of ordinary skill in the art at the time of the invention for the restricted editing access of Piersol to have displayed an error when a user attempted to edit a document part without proper access rights, because displayed error messages were notoriously well known in the art at the time of the invention to provide the benefit of quickly informing a user to the context of denied request. Thus the user of Piersol in view of Fein would have been provided the benefit of knowing that direct formatting document editing was prohibited within the selected documents.

Neither Piersol nor Fein teach displaying a list of available styles in response to determining that the direct formatting of the contents was not permitted. Young teaches providing a user a list of available paragraph styles for user selection (column 3, lines 22-41; column 4, lines 13-23: “user can select another style from the scrolling list”)(Fig. 2C: 212: “Apply Changes”) to be applied to a document lexical element (column 1, lines 21-27). It would

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have been obvious to one of ordinary skill in the art at the time of the invention for the user of Piersol to have been presented with a display of available styles as taught in Young, because Young teaches that a list of styles provides a convenient interface for a user to view and select a plurality of styles to be applied to a lexical document element (column 1, lines 21-27; column 4, lines 14-23: “user can select another style from the scrolling list”). Fein further teaches that displaying the list of styles in Young would provide Piersol the benefit of allowing the user to select style formatting to utilize their well known advantages (column 1, lines 54-67; column 2, lines 1-17: “advantages of styles are well known”).

-In regard to dependent claim 4, Young teaches receiving a selection of a style from the list of available styles and applying the selected style to a selected portion of the document (column 1, lines 21-27; column 4, lines 14-23: “user can select another style from the scrolling list”).

-In regard to dependent claim 13, neither Piersol nor Fein teach in response to determining that the request comprises a request to apply formatting directly to the contents of the electronic document: displaying a list of styles available to be applied in the document; receiving a selection of a style from the list; and applying the selected style to the document.

Young teaches providing a user a list of available paragraph styles for user selection (column 3, lines 22-41; column 4, lines 13-23: “user can select another style from the scrolling list”)(Fig. 2C: 212: “Apply Changes”) to be applied to a document lexical element (column 1, lines 21-27). It would have been obvious to one of ordinary skill in the art at the time of the

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invention for the user of Piersol to have been presented with a display of available styles as taught in Young, because Young teaches that a list of styles provides a convenient interface for a user to view and select a plurality of styles to be applied to a lexical document element (column 1, lines 21-27; column 4, lines 14-23: “user can select another style from the scrolling list”). Fein further teaches that displaying the list of styles in Young would provide Piersol the benefit of allowing the user to select style formatting to utilize their well known advantages over direct formatting (column 1, lines 54-67; column 2, lines 1-17: “advantages of styles are well known”).

-In regard to dependent claim 14, Piersol teaches denying a request to edit a document part based on limited access rights (column 18, lines 31-67; column 19, 1-31: “a user can retrieve an entire document to view it and edit the individual parts as desired”).

Piersol does not specifically teach receiving a request to create a new style. Both Fein and Young teach receiving a request to create a new style (Fein: column 1, lines 29-34: “user can also define styles”)(Fig. 2B: “Create and store newly defined style”)(Young: Fig. 2A-2C: “New Style”). It would have been obvious to one of ordinary skill in the art at the time of the invention for Piersol to have allowed the creation of new styles, because Fein teaches that by creating new styles a user could define a reusable style that could utilize the well known style advantages (column 1, lines 54-67; column 2, lines 1-17: “advantages of styles are well known”). Thus the users with complete access rights of Piersol would be provided the benefit of enforcing the new style to all the parts of the document. It also would have been obvious to one of ordinary skill in the art at the time of the invention for Piersol to have blocked the creation of new styles, because Piersol teaches that some parts of the document have limited rights access (column 18, lines 31-

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67; column 19, 1-31: “a user can retrieve an entire document to view it and edit the individual parts as desired”) for editing, and thus the users of Piersol with limited access rights wouldn’t be able to change the intrinsic contents with said newly created style.

-In regard to dependent claim 15, Piersol teaches denying a request to edit a document part based on limited access rights (column 18, lines 31-67; column 19, 1-31: “a user can retrieve an entire document to view it and edit the individual parts as desired”).

Piersol does not specifically teach receiving a request to modify a style; and denying the request to modify a style. Both Fein and Young teach modifying a style (Fein: column 2, lines 1-32: “redefine the ‘chapter title’ style”)(Young: Fig. 2A: “Update Style”). It would have been obvious to one of ordinary skill in the art at the time of the invention for Piersol to have allowed the modification of styles, because Fein teaches that by modifying styles a user could define a reusable style that could utilize the well known style advantages (column 1, lines 54-67; column 2, lines 1-17: “advantages of styles are well known”). Thus the users with complete access rights of Piersol would be provided the benefit of enforcing the modified style to all the parts of the document. It also would have been obvious to one of ordinary skill in the art at the time of the invention for Piersol to have blocked the modification of styles, because Piersol teaches that some parts of the document have limited rights access (column 18, lines 31-67; column 19, 1-31: “a user can retrieve an entire document to view it and edit the individual parts as desired”) for editing, and thus the users of Piersol with limited access rights wouldn’t be able to change the intrinsic contents with said modified style.

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-In regard to dependent claim 16, Piersol teaches importing new content into the electronic document (column 17, lines 62-67; column 18, lines 1-31: “contents moved from one document to another...user has selected an object and dragged it to its intended destination”), wherein determining whether the requested operation was permitted comprises determining whether the new content contains one or more styles that are not permitted to be applied to the contents (column 17, lines 62-67; column 18, lines 1-31: “determines whether they belong to the same category...styled text and the destination is plain text”), and further comprises replacing the styles contained in the new content that are not permitted with a permitted style prior to importing the new content (column 17, lines 62-67; column 18, lines 1-31: “the system converts the selected information into the same type as the destination document”).

Allowable Subject Matter

14. Claims 19 and 20 are allowed.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Please note the additional prior art reference cited on the accompanying PTO-892 form.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L. Basehoar whose telephone number is (571)-272-4121. The examiner can normally be reached on M-F: 7:00am - 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam L. Basehoar

